

REMARKS

Claims 1-42 are now pending in the application. The amendments to the claims contained herein are of equivalent scope as originally filed and are being made to simply clarify the scope of applicant's invention and, thus, are not narrowing amendments. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 112

Claim 11 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended claim 11 to provide sufficient antecedent basis for the claim limitations objected to by the examiner. The amendment is straightforward and a further explanation does not appear necessary.

REJECTION UNDER 35 U.S.C. § 103

Claims 1, 2-3, 9-11, 13-18, 26-28, 31 and 33-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nutter et al. (U.S. 2002/0178029).

Nutter et al. discloses a system and method to determine the likelihood of obtaining a license for a large number of patents or other intellectual property. ¶0004. The method includes a two level system wherein the first level includes receiving a plurality of input scores for each of a plurality of intellectual properties. The input scores are combined to form a scale value for each of the intellectual properties. The scale

values are compared to determine a select group. ¶0022. The second level includes applying a licensability rating to the patents in the initial or select group. ¶0022. The licensability rating is a subjective evaluation made by a group of experts in the technical area of the patent. ¶0026. This information is used to determine a second level score. ¶0022.

Turning now to claim 1, claim 1 has been amended to include a plurality of modules wherein each of said modules has a plurality of value drivers. In addition, claim 1 further includes a plurality of weighting factors, the weighting factors determined by the opportunity being evaluated. As set forth in claim 1, a weighting factor is assigned to each of the plurality of value drivers, plurality of user-specified variables and to each of said modules. Further, as set forth in claim 1, the processor is operative to calculate a score for each of said modules. Nutter et al. does not disclose a plurality of modules, nor does it disclose calculating a score for each module. Instead, Nutter et al. discloses a two level process wherein at the first level, a plurality of input scores are used to determine or form a group of patents. The specific group of selected patents then passes to the second level or level two analysis wherein an additional criteria is applied to further winnow the first group to a selection based on the second-level scores. Accordingly, only those patents with the highest level two scores merit further investigation. ¶0022. Further, to the extent Nutter et al. discloses applying a weighting factor to a plurality of licensing factors used in the level two analysis, these factors are a subjective evaluation and are not disclosed as being made by a processor operative to calculate a score relative to a licensing module. Accordingly, claim 1 as amended is now in condition for allowance.

Regarding claim 2, Nutter et al. does not disclose varying the pre-weighting factors assigned to each of the plurality of value drivers depending upon the particular selected opportunity. Paragraph 0025 of Nutter et al. merely discloses use of a weighted average of input scores relating to licensing parameters, with paragraphs 0027 and 0030 disclosing the same information. Accordingly, claim 2 as amended is now in condition for allowance.

Regarding claim 3, Nutter et al. does not disclose a market module as one of a plurality of modules having a plurality of value drivers. As disclosed Nutter et al. is concerned with establishing a list of potential licensees based on market factors, not evaluating the market with respect to the selected or entered opportunity. In short, Nutter et al. evaluates two levels, first determining a scale value for a particular patent based on selected criteria and second establishing a licensability rating based on a plurality of factors, one of which includes an evaluation of market factors. It is the licensability rating that is used to further evaluate and select from those patents originally selected based on the level one criteria. Accordingly, as amended claim 3 is in condition for allowance.

Regarding claim 9, claim 9 as amended includes as an element an efficiency module having a plurality of value drivers relating to the efficiency of the entered opportunity. As set forth in claim 9, it is the efficiency of the opportunity that is being assessed. The efficiency module gathers information regarding the overall effect of the opportunity on those who take advantage of the opportunity; for example, the overall effect of the opportunity on the user of the opportunity. Nutter et al. merely addresses licensing parameters in determining a method to further eliminate individual intellectual

properties that do not achieve an upper-level score. Accordingly, Nutter et al. provides a method for quickly screening a large portfolio and reducing it to a manageable size based on certain minimum criteria along with a subjective evaluation made by group of experts in the technical area of the patent. To the contrary, the present invention assigns a relative calculated value to an entered opportunity and accordingly prioritizes the value of each opportunity. Accordingly, claim 9 as written is in condition for allowance.

Regarding claim 10, the examiner is taking constructive notice that it would have been obvious to include or place the factors of claim 10 into a module, weight the value drivers, calculate a score for the module and use that module score along with other module scores to evaluate the entered opportunity. Nutter et al. does not disclose or use these factors to evaluate an entered opportunity. Accordingly, applicant submits that claim 10 as written is allowable.

Regarding claim 11, Nutter et al. fails to disclose the claim element wherein the impact module has value drivers relating to the overall impact of the entered opportunity on a licensee product and a licensee customer. Nutter et al. discloses the determination of a licensing priority code to further screen a group of intellectual properties. Again, Nutter et al. does not disclose assigning a relative calculated value to each opportunity based on a plurality of modules having user-specified variables with one of those modules being an impact module. Accordingly, claim 11 as amended is in condition for allowance.

Regarding claims 13 and 14, both of these claims are dependent from claim 2, which as set forth above has been placed in condition for allowance. Accordingly, allowance of these dependent claims is respectfully requested.

Regarding claim 15, claim 15 requires calculating the score of each of said modules along with a total score of the entered opportunity. Nutter et al. does not disclose calculating a score for each module and using each of the module scores to calculate a total score. Accordingly, claim 15 is in condition for allowance.

Regarding claims 16 and 17, both of these claims are dependent upon claim 15, which as set forth above has been placed in condition for allowance. These claims add as additional elements that the calculated total score is a pre-determined weighted average of the module scores and that the module score for each of said modules is a predetermined weighted average of the user-specified variables. Nutter et al. does not disclose either of these elements. Accordingly, these claims are allowable as presented.

Regarding claim 18, claim 18 is dependent upon claim 15, which as set forth above has been placed in condition for allowance. Applicant respectfully requests allowance of claim 18. Further, claim 18 requires that the database notify the recipient about the entered opportunity and corresponding total and module scores. This element is not shown in Nutter et al.

The examiner has rejected claims 26-28, 31 and 33-38 as reciting equivalent limitations to claims 1-3, 11 and 13-18. Turning briefly to claim 26, claim 26 has been amended to include a plurality of modules, each of said modules having a plurality of drivers and providing a plurality of weighting factors wherein each of said weighting

factors is determined by the opportunity being evaluated. Further, assigning a weighting factor to said plurality of user-specified variables and each of said modules. In addition, the claim requires calculating both an opportunity value for each entered opportunity and a module score for each of said modules. Nutter et al. does not disclose a plurality of modules nor does it disclose a plurality of weighting factors wherein the weighting factors are determined by the opportunity being evaluated. Further, Nutter et al. does not disclose calculating the module score for each of the modules. Accordingly, as amended claim 26 and the claims dependent therefrom are in condition for allowance. Further, with respect to the remainder of the claims, Applicant has amended these claims and as written they are allowable based the same arguments and rationale set forth above with respect to claims 1-3, 11 and 13-18.

The examiner has rejected claims 4-8, 19-25, 29-30, 39 and 41-42 under 35 U.S.C. §103(a) as being unpatentable over Nutter et al. (U.S. 2002/0178029) in view of Elliott (U.S. 2002/0178029). Elliot discloses assigning a monetary value to a patent for the purpose of using it as a security interest. Specifically, it deals with a method to determine the securitizable value of an intellectual property, and whether the owner of intellectual property will be benefited by securitizing the intellectual property. ¶0029.

Claim 4 includes a limitation that the marketability module includes value drivers relating to ownership of the entered opportunity. While Eliot teaches that an essential element of the method disclosed therein includes transferring title from one owner to another including the use of a license, Elliot fails to provide any disclosure relating to a marketability module and using the module to determine a module score used to calculate an opportunity value. Elliot simply points out that ownership is an essential

element in determining the securitization value of intellectual property. Other than making a statement that Eliot discloses value drivers related to ownership of the entered opportunity, which as set forth above Applicant disagrees with, the examiner has provided no reason, including any teaching or suggestion, as to why Elliot should be combined with Nutter et al. The scope of the prior art is significantly different in that Elliot deals with establishing a valuation and correspondingly securitizing intellectual property assets while Nutter et al. discloses utilizing a plurality of input scores to form a scale value for each of a plurality of patents. While both patents deal with evaluating intellectual property, they are evaluating different aspects and in different ways. The examiner has provided no reason why a person of ordinary skill in the art would combine the two patents as proposed by the examiner. As set forth above, applicant's claimed invention, as set forth in claim 4, differs between from the prior art in that it provides a market module, which includes value drivers relating to ownership of the entered opportunity. Neither reference discloses such a module nor uses ownership of the entered opportunity as one factor in determining or calculating a score for the specific module. Accordingly, applicant submits that the subject matter of claim 4 would not have been obvious at the time the invention was made based on a combination of Nutter et al. and Elliott.

Regarding claims 5-8 these claims on allowable for the same reasons as claim 4. Specifically, each of the claims deals with a specific module having a plurality of value drivers wherein the value drivers are used to calculate a score for the particular module. Nothing in either reference discloses this claim element. Accordingly, claims 5-8 are allowable as written.

Regarding claim 19, claim 19 requires a plurality of modules, a predetermined weighting factor linked to each of said modules and a processor operative to calculate a score for each of said modules using the user-specified variables. Neither Nutter et al. or Elliot as set forth above discloses a predetermined weighting factor linked to each of said modules and a processor operative to calculate a score for each of said modules using the user-specified variables. Further, contrary to the examiner's position, neither reference discloses a market module, a cost module, and efficiency module, and an impact module each of which having a plurality of user-specified variables. As set forth previously, Elliot addresses a method for determining the value of intellectual property; it does not disclose a system by which licensing opportunities are prioritized by assigning a relative calculated value to every opportunity. Accordingly, applicant submits that the combination of Nutter et al. and Elliot fails to render applicant's claimed invention obvious and respectfully requests allowance of claim 29.

Claims 20-24 address the contents of the various modules and the value drivers used or associated therewith. As set forth previously, these modules and the value drivers are not disclosed in the references cited by the examiner. Accordingly, these claims are in condition for allowance.

Regarding claim 25, claim 25 includes as an element using a predetermined weighted average of the user-specified variables within a module for at least one module score and a predetermined weighted average of the module scores used for total score determination. These elements are not shown in the prior art cited by the examiner. As such, applicant respectfully requests allowance of claim 25.

Regarding claims 29-30, these claims are directed to the individual modules, including a cost module and an efficiency module, neither module nor the use thereof for prioritizing an opportunity by assigning a relative calculated value to the opportunity is disclosed in either Nutter et al. or Elliot. In addition, the subject matter of these claims would not have been obvious based on a combination of these references as the prior art, specifically Nutter et al. and Elliot, does not disclose these claim elements.

Regarding claim 39, claim 39 is a method to prioritize licensing opportunities by assigning a relative calculated value to every opportunity. The method includes providing a plurality of modules, including a market module, a cost module, and efficiency module and an impact module. Further, the method includes applying predetermined weighting factors to each of the plurality of value drivers set forth in each of the above modules. In addition, a total score is calculated for the opportunity and for the each module by using a predetermined function for each of the user-specified variables. Contrary to the contention of the examiner, the prior art, specifically Nutter et al. and Elliot, does not disclose calculating a total score and module scores for each entered opportunity. Specifically, claim 39 requires calculating a module score for each module based on predetermined weighting factors assigned to each of the plurality of value drivers located in the specific module. Since the prior art does not show this alone or in combination, applicant submits a claim 39 is in condition for allowance and respectfully requests the same.

Regarding claims 41-42, these claims depend from claim 39, which as set forth above, is in condition for allowance. In addition, claim 42 requires use of a predetermined weighted average of the module scores to determine a total score. This

element is not shown in the prior art. Accordingly, claims 41 and 42 are now in condition for allowance.

With respect to claims 12, 32 and 40, these claims are dependent from base claims, which are now in condition for allowance, and allowance of these claims is respectfully requested.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested.

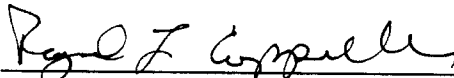
The Examiner is invited to telephone the applicant's undersigned attorney at (313) 337-1069 if any unresolved matters remain.

Please charge any cost incurred in the filing of this amendment, along with any other costs, to Deposit Account No. 06-1510. If there are insufficient funds in this account, please charge the fees to Deposit Account No. 06-1505.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 364-0200.

Respectfully submitted,

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Dated: January 5, 2007

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